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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,472	04/06/2001	John Tree	SONI-6400	6150

7590

09/25/2003

VALLEY OAK LAW
5655 SILVER CREEK VALLEY ROAD
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EXAMINER

MISKA, VIT W

ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,472

Applicant(s)

TREE, JOHN

Examiner

Vit W. Miska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-10,13,21 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by the patent to Kalbermatter et al. The reference discloses an electronic

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watch including display unit 4,5, 13, 15 with plurality of display panels 13 or 15, input unit 10 for inputting data marks, the display unit displaying the data marks on display panels 13 or 15, time display 4,5,63, liquid crystal display 15, and strap (Fig. 1).

2. Claims 21-23, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Lizzi et al. the patent discloses a method comprising receiving a data mark via 14, displaying the data mark on the display by illuminating the display panel as shown in Figs. 4A-4E and described at col. 4, lines 12-27, determining the maximum number of data marks received (pager full) see col. 5, line 11, outputting a display signal at 80.

3. Claims 27 and 30-32 rejected under 35 U.S.C. 102(e) as being anticipated by the Patent to Deguchi. The reference discloses a method comprising detecting connection of marker device 100 (Fig. 14) to gateway device 10, transmitting stored data marks to the gateway device, receiving data corresponding to the data marks and displaying the data on the display of device 100, (see col. 13, lines 55 through col. 14 line 17 for description of these steps).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deguchi in view of Lebby et al. The Deguchi patent has been noted above and additionally includes input means 20. The reference further suggests that marker 4 may be incorporated into "something which is used while moving or portably used" (col.5, lines 68-69) or a radio receiver (line 55). Lebby et al discloses a watch and radio receiver combination. One skilled in the art having both references would thus be taught that device 4 of Deguchi, i.e. radio receiver 100 may be incorporated into a wristwatch, as done in Lebby et al to provide for convenient and portable use of the radio. With respect to claims 15-20, Deguchi further suggests infra red communication with an external device, col. 6 line 34, external computer, col.6, line 57, and music marks displayed in Fig. 13. Regarding claim 14, a button 20 is disclosed for both radio and television input. However, it would be obvious to one skilled in the art that more than one such button may be provided as a means to differentiate between the two types of data input into device 4.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lizzi et al. The maximum number of data marks would be limited by the storage capacity of the memory and therefore would be a quantity which one skilled in the art would consider as an obvious design variable.

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6. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deguchi. The steps of resetting or deleting the data marks would be obvious to one skilled in the art. It is well known to delete data from a memory manually or automatically to clear the same (e.g. in a portable calculator) and one skilled in the art would provide this feature as an obvious means for deleting old data in the Deguchi device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 703-308-3096. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 703-308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.

VM
9/2/2003



Vit Miska
Primary Examiner